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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/911,152

07/23/2001

Michael L. Howard

2291.2.14

4493

21552

7590

10/17/2005

MADSON & METCALF  
GATEWAY TOWER WEST  
SUITE 900  
15 WEST SOUTH TEMPLE  
SALT LAKE CITY, UT 84101

EXAMINER

TRAN, PHUC H

ART UNIT

PAPER NUMBER

2668

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,152

Applicant(s)

HOWARD ET AL.

Examiner

PHUC H. TRAN

Art Unit

2668

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Regarding to claims 1 and 8, “wherein the gateway comprises device information about the embedded device” was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art at the time the applicant was filed. In the specification (page 9, lines 10-15) discloses:

*“Figure 5 illustrates an embodiment of a gateway 30b. The gateway 30b provides access to the embedded device(s) 26. In the present embodiments, device information 42 about the embedded devices 26 connected to the gateway 30b are stored. This information 42 may include the capabilities of each device, interfaces supported, the data available, etc. This information 42 may indicate what data/services are available at the embedded device 26 and what data types, if any, are used with individual services. This facilitates access via the gateway 30b to the embedded device 26.”*

The device information 42 is inside the embedded devices 26 as Fig. 6 that is not comprised by the gateway 30b. Therefore, the limitation of the amendment is not described in the specification.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Tonnby et al. (U.S. Patent No. 6295293 B1).

- With respect to claims 1 & 8, Tonnby teaches a combined telephone network interface and gateway for facilitating communications through use of a telephone with an embedded device and for facilitating communications between a remote service provider and the embedded device (e.g. Fig. 4), the combined telephone network interface and gateway comprising:

a telephone interface for electronic communication with a telephone (29 in Fig. 4);

an external telephone network interface for connecting the telephone network interface to an external telephone network (e.g. PSTN/ISDN in Fig. 2);

a gateway for electronic communications with the embedded device (block 24 in Fig. 6), the gateway being programmed to communicate with the embedded device, and the gateway also being programmed to enable communications with the embedded device from a control service provider (9 and 32 in Fig. 6);

connection control (12 in Fig. 3), the connection control operating to cause the telephone to be selectively in electronic communication with the external telephone network for telephone calls such that a user at the telephone is capable of dialing out and is capable of receiving an incoming telephone call (e.g. the telephone dial up to IPNT and to the server), and the connection control operating to selectively cause the telephone to be in electronic communication with the gateway for communicating with an embedded device such that device requests from the telephone are communicated to the gateway (col. 10, lines 50-56), wherein the gateway is in electronic communication with the embedded device, and the connection control operating to selectively cause the gateway to be in electronic communication with the external telephone network to enable electronic communications between a control service provider and the gateway (e.g. the block 24 communication with PSTN in Fig. 7).

- With respect to claims 2, and 9, Tonnby further comprising a plurality of telephone interfaces for electronic communications with a plurality of telephones (e.g. 5).

- With respect to claims 3, and 10, Tonnby discloses wherein the control service provider communicates with the telephone network interface through use of a telecommunications network (e.g. PSTN).

- With respect to claims 4, and 11, Tonnby teaches wherein the control service provider communicates with the telephone network interface through use of a global computer network (e.g. internet in Fig. 5).

- With respect to claims 5, and 12, Tonnby discloses wherein the control service provider communicates with the telephone network interface through use of a computer network (e.g. block 6 in Fig. 5).

- With respect to claims 6, and 13, Tonnby teaches wherein the control service provider includes schedule data to indicate when certain messages are to be sent to certain embedded devices (col. 11, lines 11-18).

- With respect to claims 7, and 14, Tonnby discloses wherein the control service provider includes device location data to indicate the address of certain embedded devices (col. 3, lines 13-24).

#### ***Response to Amendment***

5. Applicant's arguments filed 08/04/05 have been fully considered but they are not persuasive.

- In response to the Applicant's argument, the gateway does not comprise device information of the embedded device as the limitation of the claim.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H. TRAN whose telephone number is (571) 272-3172. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuc Tran  
Assistant Examiner  
Art Unit 2664

P.t  
4/29/05



DANG TON  
PRIMARY EXAMINER